

REMARKS

This amendment is in response to the Final Official Action mailed November 22, 2005.

Claims 17-49 have been withdrawn as a result of an earlier restriction requirement.

Claims 1-16 remain in the case, and are presented for the Examiner's consideration in view of the following remarks.

The Examiner has rejected claims 1-16 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication Ser. No. 2002-0178364 to Weiss ("Weiss").

The Present Invention

The Applicants have invented a system for real-time updating of shipping addresses by the address owners, and real-time retrieval of those addresses by shippers of goods. In a simple embodiment of the invention, a consumer orders a widget from an Internet merchant, and, in place of a shipping address in the ordering form, the consumer places a network pointer to the an address updating service according to the invention. When a shipper is ready to deliver the widget, the shipper follows the pointer to a current address where the widget can be shipped. The consumer has the ability to enter multiple addresses and corresponding time periods when the consumer will be at those addresses.

An exemplary embodiment of the invention is claimed in amended claim 1, which is directed to a system for entering shipping address data by a shipping address owner and for providing real-time shipping address information. That system includes a shipping address directory system server, and computer-readable storage media accessible to the server. The storage media contains an online shipping address directory composed of at least one shipping address entry. The shipping address entry contains a name of a shipping address owner, a

shipping address for the shipping address owner, a beginning date for the shipping address, and an ending date for the shipping address.

The system also includes computer-readable storage media containing instructions executable by the server, whereby the shipping address and the beginning date and the ending date for the shipping address may be changed by the shipping address owner to reflect the shipping address for the shipping address owner on a specific date.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-16 under 35 U.S.C. § 103(a) as unpatentable over Weiss.

Weiss discloses a secure registry system that provides secure access to a database that contains personal data such as a person's address (Weiss, Abstract; para. [0048]; FIG. 3). The Weiss system is said to provide a universal identification system wherein personal, financial or other information is provided to an entity based on authorization from an authorized user (Weiss [0012]). For example, identity verification information may be provided to an entity without providing personal information to the entity (Weiss [0013]).

As noted by the Examiner, Weiss does not disclose a data structure containing an ending date for a shipping address. The Examiner further notes that Weiss does not disclose computer-readable storage media that contains instructions executable by the server whereby the shipping address may be changed by the shipping address owner to reflect the shipping address for the shipping address owner on a specific date.

Additionally, while the Examiner states that Weiss discloses a data structure containing a beginning date for the shipping address, Applicants are unable to locate such a disclosure in

Weiss, and request that the Examiner designate the particular part of that reference relied upon for the rejection.

The Examiner asserts that, while those elements of claim 1 are not specifically disclosed in Weiss, it would have been obvious to one skilled in the art to “include any additional type of information since the descriptive material does not interact with media in any sense essential to establish patentability.” Applicants respectfully disagree, and submit that the executable instructions, as well as the dates for the addresses, contained on the computer readable storage media of claim 1, are functional descriptive material and are therefore statutory subject matter that must be considered in assessing patentability.

The Examiner has cited M.P.E.P. § 2114 in arguing that the limitations at issue are an intended use, and that “a recitation of an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.” (Final Office Action of 11/22/05 at 3-4). The Examiner concludes that, in the present case, “the prior art teaches all the structural limitations of the claim” (id.), inherently concluding that none of the limitations at issue are structural.

The Patent Office, however, has provided specific guidelines regarding descriptive material recorded on computer readable media. Specifically, the PTO recognizes two types of descriptive material: “non-functional descriptive material,” such as music, literary works and compilations or mere arrangements of data, and “functional descriptive material” such as data structures and computer programs which impart functionality when employed as a computer component (M.P.E.P. § 2106(IV)(B)(1)). Clearly, the dates and computer readable instructions claimed in claim 1 are functional descriptive material as defined by the Patent Office. The

Patent Office distinguishes between the two types of descriptive material when claimed as recorded on a computer readable medium:

Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). . . .

M.P.E.P. § 2106(IV)(B)(1)) (*emphasis added*). Applicants therefore respectfully assert that the shipping address dates and executable instructions of claim 1 are "structurally and functionally" interrelated with the claimed system, and that the integration of the descriptive material into the system therefore "permits that function of the descriptive material to be realized."

The shipping address dates and executable instructions of claim 1 are structurally and functionally integrated with the system to permit a user to change the beginning and ending dates for the shipping address to reflect a shipping address on a specific date. The system of Weiss does not teach or suggest those features.

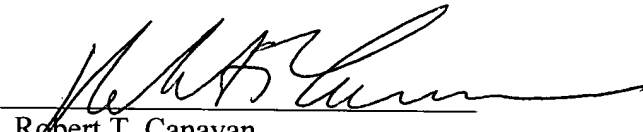
Applicants therefore submit that claim 1 is novel and non-obvious. Applicants further submit that claims 2-16, which depend directly or indirectly from claim 1, are patentable for at least the same reasons.

Conclusion

Applicants therefore respectfully assert that all the claims in the case are in condition for allowance, and earnestly request that the Examiner to reconsider the Final Rejection and issue a Notice of Allowance.

Should the Examiner have any questions regarding the present case, the Examiner should not hesitate in contacting the undersigned at the number provided below.

Respectfully submitted,

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